APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,547	06/28/2001	Kenny Tsai	3626-0208P	5124

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EXAMINER
KHATRI, ANIL

ART UNIT	PAPER NUMBER
2124	4

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/892,547	TSAI, KENNY
	Examiner	Art Unit
	Anil Khatri	2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *28 June 2001*.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-18* is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-18* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☒ All   b) ☐ Some * c) ☐ None of:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. _____.
    3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
       application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly

indicative of the invention to which the claims are directed.

The following title is suggested: "System and Method for Diagnosing Software and Calculating

Production Weight".

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

Claims 1-18 are rejected under 35 U.S.C. 101 because they discloses a claimed invention

that is not technologically embodied and just a mere program per se. See *In re Warmerdam* 33

F3d 1354, 31 USPQ2d 1754 (Fed. Cir 1994).

Analysis: Regarding claims 1-18 are software program with plurality of program segments and

modules are just to compute product weight for software to be debugged. The claims are purely

program per se and its lack of enablement therefore its functionality cannot be realized.

Therefore, the claimed invention is directed to non-statutory subject matter and claims 1-18 are

directed to non-statutory subject matter and rejected under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by *Kim et al* USPN 6,016,474.

Regarding claims 1, 4, 10 and 13

Kim et al teaches,

-   an event ratio-calculating module, which is used to calculate a production weight of the event based on the ratios of the program segments in the un-debugged software and the relation of the program segments with the event (see figure 7a,b, , column 1, lines 27, even in production version...," column 7, lines 35-44, " a typical program to be debugged... which called it")"; and

- an event-generating module, which is used to generate the event based on the production

    weight for diagnosing the un-debugged software (figures 7 and 23, column 7, lines 41-44,

    occurrence of a particular event... function which called it.

Regarding claims 2, 5, 11 and 14

Kim et al teaches,

- the ratios of the program segments in the software are automatically determined and

    generated by the event ratio-calculating module (column 10, lines 10-21, "program to be

    debugged... debug client, and column 15, lines 66-67.. debug client automatically...").

Regarding claims 3, 6, 12 and 15

Kim et al teaches,

- the ratios of the program segments in the software are determined and input by a user

    (figures 7 a, b).

Regarding claims 7 and 16

Kim et al teaches,

- the un-debugged software is applied on an operating system simulator (figures 12, 16 and

    38, column 18, lines 5-16, "debug client and debug server... the debug client").

Regarding claims 8 and 17

Kim et al teaches,

- the event-generating module randomly selects, based on the production weight of the

    event, one event from a set of events (columns 1-2. lines 48-67... software diagnostic

    tool provides user with mechanism....")

Regarding claims 9 and 18

Kim et al teaches,

- a diagnosis result recording module, which generates a diagnosis report based on the diagnosis result of the un- debugged software (column 16, lines 14-37, "the user can display... debug server in step 2508").

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anil Khatri whose telephone number is 703-305-0282. The examiner can normally be reached on M-F 8:30-5:00 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ANIL KHATRI
PRIMARY EXAMINER